

Application Number: 10/573,052
Examiner: HAVLIN, ROBERT H

REMARKS

The applicant has noted that the Examiner has withdrawn the rejection of Claim 17 over Yamada in view of the Amendment April 13, 2009.

Claim 17 has been rejected under 35 U.S.C. §102(b) as being anticipated by Chichibabin.

Reconsideration is requested in view of this Amendment.

The Chichibabin reference was applied as anticipating claim 17 because it disclosed a compound having a phenyl group corresponding to substituent A in claim 17 and a 2-quinolyl group corresponding to substituent B in claim 17 and a phenyl group corresponding to R when R is an aryl group as set forth in claim 17. The definition of A in claim 17 does not include phenyl so that there is no anticipation of claim 17 by the Chichibabin reference. In addition, the applicant has amended claim 17 to define D as being a monocyclic heterocyclic group which excludes the bicyclic 2-quinolyl group of the compound disclosed by Chichibabin.

Claim 17 has also been amended so that R is no longer aryl or arylalkyl. For these reasons, the rejection of claim 17 and claims 2 and 13 which depend from claim 17, as being anticipated by Chichibabin should be withdrawn.

The objection to claim 2 has been overcome by this Amendment which has added a period at the end of the claim.

The Examiner has objected to the pending claims as reading on non-elected subject matter.

Reconsideration is requested.

In the Office Action that was mailed November 1, 2006, the Examiner required restriction under 35 U.S.C. §121 and 35 U.S.C. §372 and pursuant to 37 CFR §1.499 required the applicant to elect one of three groups and with the election of each group of claims a further requirement was imposed to elect either a single product, method of use or single process, depending on the group that was elected. A separate requirement for the election of a species was also made.

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The applicant provisionally elected Group I and compound No. 22 as the elected species, with traverse. In the Office Action of September 11, 2008, the Examiner stated that the claims were restricted to the elected species and the remaining subject matter was withdrawn. The applicants filed a Request for Continued Examination with an amended claim 17 and the Chichibabin reference was applied as an anticipation of amended claim 17. The present application is a national stage application of a PCT application and where the PTO procedures for examining a national stage PCT application violate the provisions of the PCT Treaty, they have been held to be improper. The Examiner's citation of 35 U.S.C. §121 and 35 U.S.C. §372 as authority for the action taken in this application fail to demonstrate that they are consistent with PCT Rules 13 and 13.1. In the case of *Caterpillar Tractor v. Commissioner*, 231 USPQ 590 (ED Va. 1986), the court held that where the PTO rules run afoul of the provisions of the PCT treaty in a national stage PCT application, the provisions of the PCT treaty will control the procedure in the PTO. Article 27 of the PCT treaty explicitly provides:

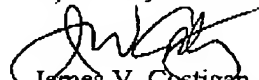
No national law shall require compliance with requirements relating to the form or contents of the international application different from or additional to those which are provided for in this Treaty and the Regulations"

It is apparent from the *Caterpillar* case that when the provisions of the USPTO when in conflict with PCT Rules 13 and 13.1, the provisions of the USPTO are not to be followed. Nothing in PCT Rules 13 or 13.1 provides for the election of a species and the withdrawal of a claim from consideration when one species is found to be unpatentable when considered according to the procedures Sections 808-809 of the MPEP. In addition, when an amended claim is presented in a national stage PCT application that excludes an unpatentable species, there is no basis for withdrawing that claim from consideration. For these reasons, it is requested that the objection to the claims as reading on non-elected subject matter be withdrawn.

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An early and favorable action is earnestly solicited.

Respectfully submitted,


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